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PATENT

Customer No. 22,852
Attorney Docket No. 05725.0623-00000

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:)
)
Gérard LANG et al.) Group Art Unit: 1751
)
Application No.: 09/600,132 /) Examiner: E. Elhilo
)
PCT filed: December 21, 1998)
)
§ 371 Date: August 14, 2000)
)
For: DYEING COMPOSITION CONTAINING)
A LACCASE AND KERATINOUS FIBRE)
DYEING METHOD)

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

RESPONSE UNDER 37 C.F.R. § 1.111

In reply to the Office Action dated February 14, 2003, Applicants respectfully request reconsideration and reexamination of the application in light of the following remarks. A Petition and fee for a three-month extension of time, extending the due date until August 14, 2003, is also enclosed.

I. Status of Claims

Claims 23-62 are pending in the application. No claims have been amended in this Response and no new matter has been added. Applicants filed an Appeal Brief in

this case on December 11, 2002. The Examiner has reopened prosecution in order to make a new rejection.

II. Information Disclosure Statement

Together with this Response, Applicants submit an Information Disclosure Statement (IDS) listing documents cited in an opposition proceeding involving the European patent corresponding to the present application.

III. Rejection under 35 U.S.C. § 103

The Examiner has rejected claims 23-62 under 35 U.S.C. 103(a) as being unpatentable over WO 97/24107 to Dias in view of WO 97/19998 to Aaslyng. The Examiner states that Dias teaches a hair dyeing composition comprising enzymes such as peroxidases, alkaline agents such as basic amino acids and alkanolamines, oxidation dyes, direct dyes, and other ingredients. Office Action at 2. The Examiner admits, however, that the "instant claims differ from the reference by reciting a hair dyeing composition comprising a laccase enzyme as an oxidizing agent." *Id.* at 3. Aaslyng, the Examiner alleges, is "analogous art of hair dyeing composition [and] teaches a composition comprising laccase enzyme as an oxidizing agent...." *Id.* Accordingly, the Examiner concludes that it would have been obvious to one of ordinary skill in the art to modify Dias by adding the laccase enzymes of Aaslyng. The Examiner finds motivation in Dias' teaching of the use of "one or more enzymes," and a reasonable expectation of success "because all the enzymes in the dyeing composition are known to provide hydrogen peroxide and, thus, are known to be oxidizing agents. Furthermore, laccase enzyme are [sic] well known in the dyeing art to be useful as an oxidizing agent." *Id.* at 3-4.

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Applicants disagree with the Examiner's reasoning and his conclusion, and therefore traverse this rejection. For a prima facie case of obviousness to be established, three basic criteria must be met by the Examiner. First, the Examiner must show that there is some suggestion or motivation, either in the cited references themselves or in the knowledge generally available to one skilled in the art, to modify a reference or combine reference teachings. Second, the Examiner must demonstrate there is a reasonable expectation of success in making the modification or combination. Finally, the prior art references must also teach or suggest all the claim limitations. See M.P.E.P § 2143. Furthermore, the teaching or suggestion to make the claimed combination must be found in the prior art, not in Applicants' disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991).

A. No Motivation to Combine References

In this case, the Examiner has failed to meet at least two of the above criteria. The Examiner suggests that "one having ordinary skill in the art would be motivated to modify the primary reference by adding the laccase enzyme as taught by Aaslyng...." Office Action at 3. This assertion, however, is directly rebutted by the disclosure in Dias, where the types of enzymes that can be used therein are specifically listed. "Suitable enzymatic materials include the commercially available lipases, cutinases, amylases, neutral and alkaline proteases, esterases, cellulases, pectinases, lactases and peroxidases conventionally incorporated into detergent compositions." Dias at 38. Laccase is noticeably absent from the list. Given the disclosure in Dias, therefore, one skilled in the art would not have been motivated to choose an enzyme not specifically taught by Dias.

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Aaslyng does not remedy this deficiency in Dias, because Aaslyng describes only the use of laccase enzymes. That the Examiner asserts "all the enzymes in dyeing composition are known to provide hydrogen peroxide and, thus, are known to be oxidizing agents" (Office Action, pp. 3-4) is hardly a motivation for making the substitution proposed by the Examiner. The law requires that "[t]he factual inquiry whether to combine references must be thorough and searching [and] . . . be based on objective evidence of record." *In re Lee*, 277 F.3d 1338, 1343 (Fed. Cir. 2002). Broad conclusory statements regarding the teachings of multiple references, standing alone, are not "evidence." *In re Dembiczak*, 175 F.3d 994, 999 (Fed. Cir. 1999). Further, "particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected *these compounds in the manner claimed*." *In re Lee*, 277 F.3d at 1343 (emphasis added), quoting *In re Kotzab*, 217 F.3d 1365, 1371 (Fed. Cir. 2000).

Here, no "objective evidence" of "particular findings" has been presented, nor does any exist as to the reason why one of ordinary skill in the art, reading the specific list of enzymes in Dias, would consider substituting a different enzyme. Not only that, Dias discloses its enzymes as an optional "additional material useful" in its compositions, but not as the sole oxidizing agent. Instead, all of Dias' compositions require a water-soluble peroxygen oxidizing agent, defined as an inorganic peroxygen material capable of yielding hydrogen peroxide in aqueous solution. Dias at 8. The presence of the enzyme is secondary in Dias. In contrast, laccase is the only oxidizing agent taught by Aaslyng. So, in order to make a proper substitution that results in the presently claimed invention, the Examiner would have to replace Dias' peroxygen

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oxidizing agent *and* optional enzyme with Aaslyng's laccase. There is certainly no motivation to do that.

Without a suggestion for modification in the references themselves, the Examiner cannot properly make this rejection. Indeed, the Examiner *must* point specifically to a suggestion regarding the proposed modification, as it is impermissible to base a rejection on hindsight analysis alone. Here, the Examiner has not pointed to any actual, objective evidence of record that would have led one of ordinary skill in the art to expect the feasibility or utility of such a modification, as suggested by the Examiner.

B. No Reasonable Expectation of Success

Further, Aaslyng does not teach or suggest the use of its laccase with any alkalizing agent, let alone any of the buffering compounds listed in Dias. Therefore, even if one attempted to use a laccase in place of the enzymes listed by Dias, the references do not suggest any reasonable expectation of success for this additional reason. The formulation of oxidation dyes is an "extremely complicated" matter according to Zviak, THE SCIENCE OF HAIR CARE, 271-272 (Charles Zviak ed., 1986). The results of major oxidative coupling reactions are known (*i.e.*, the color obtained can generally, but not always, be predicted), but as Zviak points out, "any varying element can cause a major change." *Id.* at 272, lines 25-26 (emphasis added).

Thus, the Examiner has failed to provide any evidence to show why one of ordinary skill in the art would have reasonably expected a successful dye to be formed from the proposed combination of references. Accordingly, the rejection is improper and should be withdrawn.

IV. Conclusion

In view of the foregoing, Applicants respectfully request the prompt allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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Dated: August 7, 2003

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